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IN THE

Supreme Court of the United States

October Term, 1970.

No. 338.

BLONDER-TONGUE LABORATORIES, INC.,
Petitioner,

v.

UNIVERSITY OF ILLINOIS FOUNDATION and JFD ELECTRONICS CORPORATION,
Respondents.

MOTIONS OF BLUMCRAFT OF PITTSBURGH OPPOSING MOTION OF KAWNEER COMPANY, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE

and

BRIEF AMICUS CURIAE OF BLUMCRAFT OF PITTSBURGH.

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Blumcraft of Pittsburgh respectfully moves the Court to reconsider its Order of January 18, 1971 granting the Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Curiae and to deny said Motion of Kawneer Company, Inc. and in the alternative, Blumcraft respectfully moves for leave to file the attached Brief Amicus Curiae in opposition to the Brief filed by Kawneer Company, Inc.

Kawneer Company, Inc. successfully moved for leave to file Brief Amicus Curiae on the basis that a motion for summary judgment filed by Kawneer Company, Inc. in the pending suit *Blumcraft of Pittsburgh v. Kawneer Company, Inc.*, No. 12,847, Northern District of Georgia "raises the same question presented in the instant case". No

notice was or has been given to Blumcraft or its counsel that such motion had been filed until after it was granted by the Court.

The Georgia action raises a different question than that presented in the present case and Kawneer Company, Inc. was considerably less than candid in contending that the Georgia action involved merely a prior determination of patent invalidity against a different defendant when in fact the patent in the Georgia case had first been held *valid and infringed* in a first adjudication by the United States Court of Claims respecting the very products of Kawneer involved in the Georgia action.

In the instant case the patent in suit was first held *invalid* in the Eighth Circuit and was subsequently held valid in a second suit in the Seventh Circuit. The Court of Appeals for the Eighth Circuit was faced only with a single prior adjudication of invalidity. This presents the question of *Triplett v. Lowell* as evidenced by the Court's request that the parties address themselves to that question. Even assuming that the Court should determine to reverse *Triplett v. Lowell* in the present case, that would not reach the question presented in the Georgia action, the third suit involving the patent, where the patent is the subject of a prior holding of *validity*.

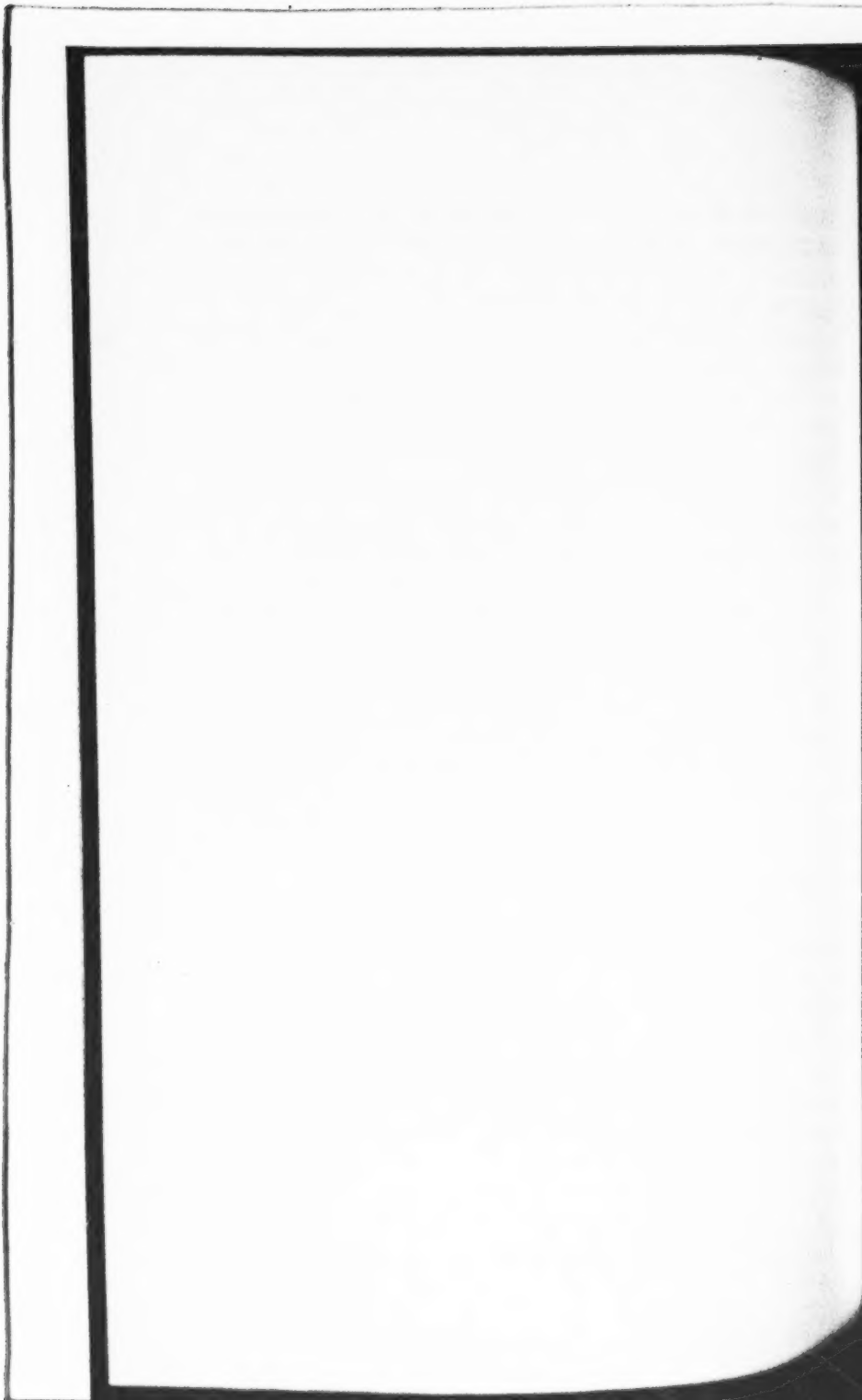
The Brief filed by Kawneer Company, Inc. is the only brief filed in the present action supporting the reversal of *Triplett v. Lowell*. Kawneer's silence with respect to the prior adjudication of validity of the patent in the Georgia case involving its own products could have resulted in the Court's treating the question of *Triplett v. Lowell* as though it involved the same question as presented in the Georgia action although this is not the case. The presence of Kawneer Company, Inc. in the present case as *amicus curiae* upon the false premise that the question in the Georgia action is the same as that in the instant case lends

itself to broadening *sub silentio* the Court's consideration of *Triplett v. Lowell* beyond the facts of the present case. In order to avoid the erroneous implication that the present case is the same as the Georgia action, the Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Curiae should be reconsidered and denied.

In the alternative, Blumcraft requests permission to file its Brief Amicus Curiae urging that the holding of *Triplett v. Lowell* be adhered to for the very reason that to do otherwise would lead to intolerable confusion in the administration of the patent system, particularly where, as in the *Blumcraft* case, the patent has first been held valid.

Respectfully submitted,

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The question is whether the Court should overrule the holding of *Triplett v. Lowell*, 297 U. S. 638, 642 (1936) that "neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant."

STATEMENT.

Although invited by the Court to brief and argue the question presented, both petitioner and respondents have urged the Court, for good reasons, to reaffirm the holding of *Triplett v. Lowell*. Only Kawneer Company, Inc. has urged the Court to reverse it in furtherance of its position in a pending suit between Kawneer and Blumcraft.

The case in which Blumcraft and Kawneer are involved is not the same as the instant case or *Triplett v. Lowell*, for the reason that in the Blumcraft case the patent was first held valid over prior art in one suit, invalid over the same prior art in a second suit and is now involved in a third suit. It is Blumcraft's position that by overruling the holding of *Triplett v. Lowell* as stated above the Court could not decide the question involved in the case between Blumcraft and Kawneer. It is further Blumcraft's position that the facts in the Blumcraft case amply demonstrate the soundness of the holding of *Triplett v. Lowell*.

ARGUMENT.

I. The Holding of *Triplett v. Lowell* Is Based Upon Reason and Authority to Permit the Orderly Administration of the Patent System.

A suit for patent infringement is an action *in personam*, not *in rem* and the cases have long held a patent can only be repealed by an adjudication in a suit by the United States that it was fraudulently obtained. *United States v. Bell Telephone Company*, 167 U. S. 224 (1896).

Kawneer urges the Court to adopt a rule that the first holding of *invalidity* of a patent in effect repeals it regardless of prior adjudications of validity. Kawneer would have a patentee litigate his patent against different infringers in different circuits, in each case requiring an independent determination of the patent's validity so long as the patent is held valid. The patentee would thus be forced to contest the validity of his patent repeatedly, even against the same prior art. Then, according to Kawneer, if the patent were ultimately held invalid in another circuit, the patent would be dead. Where this would leave the first infringers is not clear. To paraphrase Justice Jackson in *Jungersen v. Ostby & Barton Co., Inc.*, 335 U. S. 560, 572 (1949), the only valid patent would be one that had not been sufficiently litigated.

II. Kawneer Confuses Collateral Estoppel With Res Judicata.

Kawneer contends that mutuality is no longer required in the application of collateral estoppel citing the divided decision in *Bruszewski v. United States*, 181 F. 2d 419 (3 Cir., 1950). The cases indicate, however, that mutuality is by no means dead in any case. *Canaan Prod-*

ucts, Inc. v. Edward Don & Company, 388 F. 2d 540 (7 Cir., 1968). *Industrial Credit Company v. Berg*, 388 F. 2d 835 (8 Cir., 1968). Kawneer also fails, as did the court in the *Bruszewski* case, to distinguish clearly between collateral estoppel and *res judicata*. The distinction, however, was clearly drawn by the Court in *Lawlor v. National Screen Service*, 349 U. S. 332, 330 (1954):

> "Compare *Bruszewski v. United States*, 181 F. 2d 419 (C. A. 3d Cir.), on which both courts below relied. It should also be noted that the *Bruszewski* decision was an application of collateral estoppel and not *res judicata* as the term is used here."

The statement in footnote 6 at page 422 of the *Bruszewski* decision makes clear that the court was limiting its decision to preclude relitigation of "a question of fact." While the term *res judicata* is used by the court in that opinion, as the court pointed out in the *Lawlor* case, it was in reality applying collateral estoppel.

The significant point is that collateral estoppel may be used to prevent a litigant from retrying a question of fact which has been established in a prior case even though his opponent was not a party to that case. *Res judicata*, on the other hand, precludes a litigant from asserting his claim but the prohibition can only benefit the opposing party to the first litigation and his privies. In applying the rationale of *Bruszewski* in a patent case, the United States Court of Claims properly required that in each case it must first be determined whether the particular question in issue is redundant and therefore need not be relitigated. *Technograph Printed Circuits Ltd. v. The United States*, U. S. Ct. *of Claims*, 372 F. 2d 969 (1967).

It has never been questioned that *res judicata* or collateral estoppel can be waived by the party in a position

to claim it. Neither *res judicata* nor collateral estoppel operates automatically. Thus, the defendants in the instant case may well have avoided pleading collateral estoppel before the trial in order to make their own record against the patent. The entire matter of limiting needless relitigation is thus left in the hands of the litigant who may employ it to suit its own ends.

Kawneer's basic thesis is in error. It is not mutuality but privity that controls in the application of *res judicata* and that continues to be the law in all cases. The doctrine of collateral estoppel is available to be used upon factual questions in patent litigation as in all other litigation.

III. The Doctrine of Comity Is the Proper and Available Device to Limit Multiple Patent Litigation.

In urging the Court to adopt a rule whereby the doctrine of *res judicata* would be expanded solely to be used against the patentee, Kawneer ignores the long line of authority going back through *Triplett v. Lowell* and including *Tighlman v. Proctor*, 125 U. S. 136 (1888), in which the court made clear that so long as the patent question in issue had not been determined between the parties to the suit, each party is entitled to litigate his claim. Those cases and the court's decision in *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 489 (1899) made clear that the rule of comity may be applied to limit multiple litigation of patent claims; but that doctrine may be used both in favor of the patentee and against him, unlike Kawneer's unilateral *res judicata* which only works against the patentee.

CONCLUSION.

The circumstances of the Kawneer-Blumcraft litigation and the decisions of the Court in *Triplett v. Lowell, Tighman v. Proctor, Mast, Foos & Co. v. Stover Mfg. Co.* and the *Lawlor* case make it clear that the holding of *Triplett v. Lowell* should be sustained as the only basis upon which the patent system can be fairly administered under present legislation.

Kawneer's proposal to overrule *Triplett v. Lowell* would leave the patent system in the position where, faced with one adjudication of validity and another adjudication of invalidity, the patentee could not take advantage of the prior holding of validity while the infringer would have the full benefit of the prior holding of invalidity.

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